

### REMARKS

Claims 58-63 were pending in the case at the time of the Office Action, claims 1-57 having been previously cancelled. No claims are canceled and no new claims are presented. However, and due to the status change of claim 63, a listing of claims is presented.

#### Restriction requirement

The applicant appreciates the Examiner's agreement with the arguments presented regarding restriction. As a result of these, the status indicator of claim 63 has been changed from "withdrawn – currently amended" to "previously presented."

#### Rejection under 35 USC §103(a)

The Examiner has not repeated the prior rejection of claims 58-63 as obvious over a combination of Talaber '291 with Warden '910 and Bono '722 from the Office Action of 27 August 2007. Instead, the Examiner has made a rejection of claims 58-63 based on the combination of Talaber '291 with only Bono '722. Applicant respectfully traverses.

First, the applicant gratefully notes the annotated copy of Fig. 3 from Talaber '291, as it may be very helpful in resolving the remaining issues in this case, most of which center around the "screw retention member." Claim 58 requires "a tapered retention seat." Although the Examiner indicates that reference number 34 shows the tapered retention seat in the figure, there is no reference number 34 in the Talaber '291 figure reproduced by the Examiner, and the only place a reference number 34 appears in Talaber '291 is in Fig. 7, where it is a "head" of a securing element that would correspond to the bone screw head in the present disclosure. The applicant suggests that the structure in the Talaber '291 figure that corresponds to the claimed "tapered retention seat" is the structure below the Examiner's "1<sup>st</sup> diameter" and the "shoulder," which is consistent with the requirement in claim 58 that the tapered retention seat comprises "a shoulder formed at a bottom thereof." However, wall 21 in Talaber '291 has a uniform diameter, so it cannot be a wall of the tapered retention seat that "monotonically decreases in diameter over a height thereof", as required in claim 58.

The Examiner's only comment regarding this missing element is that it "would have been an obvious matter of design choice" and that "applicant has not disclosed

that such solve [sic] any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art [sic] would find obvious for the purpose of providing having an improved interface between the ring, bone screw and retention member to prevent backout of the screw for better fixation." In making this point, the Examiner cites *In re Dailey and Eilers*, 149 USPQ 47 (BPAI 1966), which stands for the proposition (as stated at MPEP 2144.04 (IV)(B)) that configuration of a device is a matter of skill which a person of ordinary skill would have found obvious, *absent persuasive evidence that the particular configuration was significant*. But the applicant here has done exactly that in the specification. At page 3, second full paragraph, applicant states that "a novel aspect of the invention is a resilient split ring that cooperates with angled contact surfaces in a plate for allowing convenient and fast dynamic locking between the plate and a bone screw." Further, at page 3, third full paragraph through page 4, first full paragraph, the operation of the tapered retention seat, the resilient split ring and the lifting engagement of its tapered inside diameter with threading on the head of the bone screw in concert, as described in claim 58, is described. Further support for this elegantly simple, although non-obvious and advantageous, combination of parts is found at page 9, fourth full paragraph, through page 10, third full paragraph. Particularly noteworthy is page 10, third full paragraph, where the method for removing the bone screw is described. Removal of the bone screw in a Talaber '291-type device is apparently achieved by removing the standard split ring from the non-tapered groove by manipulating the split ring using the two small holes near the split in the split ring, a technique that is significantly more complex than that described in the present application. Applicant asserts that the significance of the configuration is apparent from the foregoing.

Further, and in full accord with the Supreme Court holding in *KSR v Teleflex*, the applicant respectfully notes that a rejection under 35 USC 103 still requires that each and every element of the claim be found in combination of references made by the Examiner. However, the Examiner has failed to show the presence of the frustoconical split ring possessing the requisite structures in the combination of Talaber '291 and Bono '722.

Even further on this point, the primary reference (Talaber '291) used by the Examiner is later in time than the secondary reference (Bono '722), so if the "obvious design choice" was available to the present inventor at the time of his invention, it was similarly available to Talaber '291, who apparently chose to not adopt it. There is nothing in the teaching of Talaber '291 to suggest that he had identified the advantages of a split ring with either an inside or and outside diameter that decreases monotonically over the height, much less to have identified the advantages of having both diameters simultaneously decreasing, as is claimed in claim 58. Therefore, the Examiner's position that the particular split ring is a identifiable option with predictable result, as required by KSR, is simply not viable.

#### Conclusion

The Applicant respectfully submits that the present application is now in condition for allowance and such action is earnestly requested.

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